

REMARKS

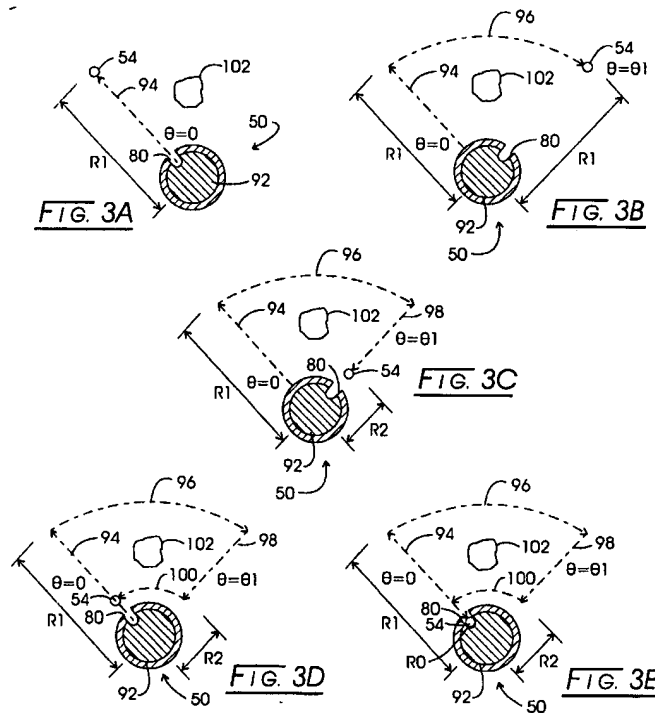
Reconsideration of the rejections set forth in the Office Action mailed May 31, 2005, is respectfully requested. Claims 47, 50-51, and 55-56 have been amended. Claims 47-63 remain pending in this case. Support for these amendments can be found in the specification at, e.g., paragraph [0030]. Therefore, these amendments are made without the introduction of new matter.

Art Rejections

Claims 47-51 and 62 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. (USP 6,514,248) in view of Eggers (USP 5,611,798). Claims 52-54 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. in view of Burbank et al. (USP 6,540,693). Claim 55 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. in view of Wilk et al. Claims 55-63 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Eggers et al. in view of Burbank, et al., and further in view of Wilk et al.

Claims 47 and 56 have been amended to specify that the separator element must be rotated about the axis to “completely separate a tissue section from surrounding tissue before radially retracting the tissue separator element.” Applicants respectfully assert that none of the cited references teach or suggest methods having all of the steps of the amended claims. In particular, the ‘248 patent of Eggers (the primary reference for all of the rejections) describes methods of separating tissue that do not rotate the separator element about the axis to completely separate the tissue section element before radially retracting the tissue separator element. Eggers states, “[w]ith this system, typically a volume of targeted tissue such as tumor is isolated by a cut

providing necrotic interfacing cut surfaces having a resultant circumscribing volume shape resembling a segment of an orange.” (Col. 5, lines 39-42). As seen in Figs.3A-E (reproduced below) and 6A-C, the tissue section is separated by manipulating the instrument to follow the paths outlined in the figures. (See, e.g., Col. 11, line 7 – Col. 12, line 5). In order to separate the tissue section, as seen in Fig. 3C, “while the forward end region 50 is at the angular orientation $\theta = \theta_1$, [the tissue separating element] is retracted toward the deployment portion 80 while carrying out electrosurgical cutting as represented by the cut indicator line.” (Col. 11, lines 42-45, emphasis added).



As seen above, in order to completely separate the tissue section from the surrounding tissue, the separator element must be retracted at some point. In contrast to the amended claims, the tissue section cannot be completely separated from the surround tissue by only rotating the separator element about the axis according to the method taught in Eggers.

Therefore, applicants respectfully assert that the prior art does not teach or suggest each and every limitation of the claims as amended and request withdrawal of the rejections.

CONCLUSION

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
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